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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/519,538   | 12/28/2004  | Yoshiko Hino         | 47233-0049-00-US<br>(220489) | 2594             |
| 55694 7590 08/20/2009<br>DRINKER BIDDLE & REATH (DC)<br>1500 K STREET, N.W.<br>SUITE 1100<br>WASHINGTON, DC 20005-1209 |             |                      |                              |                  |
| EXAMINER   |             |                      |                              |                  |
| PADEN, CAROLYN A   |             |                      |                              |                  |
| ART UNIT   |             | PAPER NUMBER         |                              |                  |
| 1794   |             |                      |                              |                  |
| MAIL DATE  |             | DELIVERY MODE        |                              |                  |
| 08/20/2009   |             | PAPER                |                              |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/519,538

**Applicant(s)**

HINO ET AL.

**Examiner**

Carolyn A. Paden

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 6-23-09

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanebo (JP 06-292544) in view of Weyersbach (5,389,394).

Kanebo discloses the preparation of a beverage containing fats and oils that is filled into a hermetically sealed container. Extracted solutions of cocoa beans are mixed with water and an emulsifying agent and the mixture is heated to less than 85C and then homogenized (abstract and Table 1). The homogenization step is said to create a stable beverage solution. The claims appear to differ from Kanebo in the preparation of the extract and in the use of a centrifuge in the process. Rusoff teaches extracting cocoa beans with hot water (see example 1 and column 3, lines 70-75). When fine particle sizes of the cacao beans are used, Rusoff suggests there is a need for filtering the extract (column 4, lines 39-47). The use of a centrifuge to filter the cocoa extract is described at column 4, lines

66-70. It would have been obvious to one of ordinary skill in the art to use the extraction method of Rusoff and centrifuge the extract of Kanebo to create a cacao extract containing smaller particles in it. It is appreciated that the temperature of centrifugation is not mentioned but one of ordinary skill in the art, who desired a high fat chocolate beverage, would be expected to centrifuge the cocoa above the melting point of the cocoa fat so that the fat does not solidify and be removed from the extract during processing. It is also appreciated that the fat content of the beverage is not mentioned but one of ordinary skill in the art would be expected to adjust the extent of fat extraction from the cacao nib by varying extraction time and the size of the cocoa nib as suggested by Rusoff (column 4, lines 30-44). Although milk is not mentioned, chocolate milk is known in the art. To add milk to chocolate would have been an obvious way to utilize the beverage of Kanebo.

The rejection of the claims over Weyersbach in view of Rusoff and Terauchi and Terauchi as further evidenced by Minifie have been dropped in response to applicants amendments to the claims. The rejection of the claims under 35 USC 112 has also been withdrawn

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached by dialing 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Carolyn Paden/

Primary Examiner 1794